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20350 7590 02/19/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER YANG, NELSON C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KURT E. PETERSEN, MICHAEL T. TAYLOR,
FARZAD POURAHMADI, WILLIAM A. McMILLAN,
RONALD CHANG, STANLEY H. SAKAI, JESUS CHING,
DOUGLAS B. DORITY, PHILLIP BELGRADER, AND
M. ALLEN MORTHRUP

Application No. 09/970,434
Technology Center 1600

Mailed: February 19, 2009

Before CAROLYN L. JOHNSON, *Supervisory Paralegal Specialist*.
JOHNSON, *Supervisory Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on August 28, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the

application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF, STATUS OF CLAIMS

A review of the file finds that the status of the claims as provided in the Appeal Brief filed February 13, 2006 under the heading "Status of Claims" is not consistent with the status of claims of record in accordance with 37 CFR 41.37(c)(1)(iii). The status of the claims as provided in the Appeal Brief must be consistent with the last **entered** amendment. Each claim on appeal must be identified. *See also Manual of Patent Examining Procedure (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007) for details.*

A review of the last entered amendment finds that claims 1-20, 36, 38-39 and 41-75 are cancelled; and that claims 21-26, 31, 32, 35, 37 and 40 are rejected; whereas Appellants have not indicated the status of these claims. Correction of the status of all claims is required.

APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER

Appellants filed an Appeal Brief dated February 13, 2006. The Appeal Brief is not in compliance with 37 C.F.R. § 41.37(c) effective September 13, 2004.

According to 37 C.F.R. § 41.37(c) (v), an Appeal Brief must include the following:

(v) ***Summary Of Claimed Subject Matter.*** A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification **>requires<

somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. >For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 2 and 3 of the Appeal Brief filed February 13, 2006 is deficient because it does not separately map independent claim 21 to the specification. Correction is required.

MPEP § 1205.03 states in part:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

IMAGE FILE WRAPPER - MISSING REFERENCE

On May 13, 2008, the Examiner mailed an Examiner’s Answer. On pages 3 and 4, section (8), the Examiner lists a reference to Carlin, “Ultrasonics (McGraw-Hill 1960). However, a review of the Image File Wrapper (IFW) reveals that there is no copy of the Carlin reference. The Examiner must provide a copy of the missing Carlin reference.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

(1) hold the Appeal Brief filed February 13, 2006 defective, as required by 37 C.F.R. § 41.37(d);

(2) notify Appellants to file a paper properly addressing the status of all claims;

(3) notify the Appellants to submit a “paper” which corrects the Appeal Brief’s Summary of Claimed Subject Matter under 37 C.F.R. § 41.37(c)(1)(v);

(4) acknowledge and consider any “paper” submitted by Appellant to correct the Appeal Brief;

(5) for the Examiner to provide a copy of the Carlin reference, as identified in section (8) of the Examiner’s Answer mailed on May 13, 2008, and to electronically scan said reference into the IFW; and

(6) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

CLJ

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834